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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,690	09/26/2001	Daniel Suttor		6757

2292 7590 02/10/2003

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EXAMINER

MICHENER, JENNIFER KOLB

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 02/10/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,690

Applicant(s)

SUTTOR ET AL.

Examiner

Jennifer Kolb Michener

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The rejection of claims 3-7, 9 and 12 under 35 U.S.C. 112, second paragraph, has been withdrawn based on Applicant's amendments.

The rejection of claim 4 has been withdrawn in light of the new 112, 1st rejection of claim 3 below.

The following new 112 rejection is made based on Applicant's amendments:

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In an effort to correct the 112, 2nd problems associated with claim 4, Applicant has amended claim 3 to substitute the phrase "transition metals" for the word "subgroups". This language appears to be new matter. Examiner is unable to find any reference to the group "transition metals" in the originally-filed application. While Examiner notes that some of the elements listed in claim 4 are in fact species of the transition metals

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genus, the specification does not provide basis for the entire genus of "transition metals".

Claim Rejections - 35 USC § 102

4. Claims 1-8, 10-11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sadoun et al.

Examiner maintains the rejection.

Claim Rejections - 35 USC § 103

5. Claims 9, 12, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadoun.

Examiner maintains the rejection of claims 9, 12, and 14.

Examiner has also applied this rejection to newly added claims 15-17 for the same reasons as applied to claims 9 and 12 in the previous office action.

6. Claims 1-6 and 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hechler in view of Sadoun.

Examiner maintains the rejection of claims 1-6 and 8-14.

Examiner has also applied this rejection to newly added claims 15-17 for the same reasons as applied to claims 9 and 12 in the previous office action.

Response to Arguments

7. Applicant's arguments filed 11/26/2002 have been fully considered but they are not persuasive.

Applicant argues that the ceramic of Sadoun is not porous based on the citations throughout Sadoun teaching the manufacture of a "nonporous" ceramic product.

Examiner notes that in all citations provided by Applicant, that Sadoun refers to a finished product as being non-porous. Examiner acknowledges that the finished, sintered product of Sadoun is nonporous. However, Examiner maintains her position that the non-sintered ceramic of Sadoun to be colored is non-porous as is required by Applicant's claim.

Since claims require the use of porous or absorbent ceramics in the alternative, Applicant additionally argues that the ceramic particle size of Sadoun would be "virtually impervious" to penetration by a solution having the surface tension of the instant application. Thus, Applicant argues that in addition to being "nonporous", as he argues above, the ceramics of Sadoun are not "absorbent".

Examiner notes that "virtually impervious" does not exclude some penetration.

Additionally, it is not Examiner's burden to prove that Sadoun's ceramic particles are absorbent of Applicant's solution, rather Examiner must prove that Sadoun's ceramic is absorbed and colored by Sadoun's solution. The inherent porosity of Sadoun's ceramics and the fact that his ceramics are effectively colored throughout, indicate that Sadoun's ceramics are absorbent.

Applicant argues that Sadoun adds colorant prior to forming the ceramic into a pre-form, whereas Applicant's invention is highly versatile in that it can be colored either before or after shaping the ceramic.

Examiner notes that claims do not exclude Sadoun's alleged process of adding colorant prior to shaping the ceramic. In fact, Applicant even argues that his process can be colored before or after shaping, at least one of which is taught by Sadoun.

Applicant argues that the instant invention colors only after "pre-sintering of the pre-form", which is fundamentally different than the method taught by Sadoun.

Examiner disagrees with Applicant's statement that the instant invention colors only after pre-sintering of the pre-form. Instead, claims read "coloring the translucent ceramics in porous or absorbent pre-sintered state". There is a stark difference between coloring the ceramic in the pre-sintered (i.e., prior to sintering) state and Applicant's new assertion that the ceramic is colored after pre-sintering. The originally-filed claims provided no active method step of sintering the ceramic, however when read in light of the originally-filed specification, it is clear that ceramic bodies are colored, then dried, then sintered (page 7, line 23). The claims must be examined in light of the specification, therefore, the phrase "coloring the translucent ceramics in porous or absorbent pre-sintered state" must be interpreted to mean that the coloring occurs when the ceramics are in a state prior to sintering. Nowhere in the originally-

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filed specification is there any mention of a pre-sintering method step. The only active sintering step outlined in the specification occurs after the coloring step.

Applicant argues that action time would be different in Sadoun because his ceramics are non-porous.

Examiner refers Applicant to the discussion of porosity, above.

Regarding Hechler, Applicant argues that Hechler teaches firing "after the application of each coat or at least after the application of the first coat".

Examiner disagrees. Hechler teaches single or repeated application of metal oxide with *optional* ignition after each application step, with ignition carried out at least once after the final application step.

Applicant argues that Hechler tries to minimize the porosity of the substrate.

Examiner notes that the substrate must be porous to reduce its porosity. Furthermore, the alleged reduction in porosity does not require elimination of said porosity.

In response to Applicant's arguments that Hechler does not teach coloring pre-sintered parts, Examiner directs Applicant to the same discussion regarding Sadoun, above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kolb Michener whose telephone number is 703-306-5462. The Examiner can normally be reached on Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jennifer Kolb Michener
February 6, 2003



SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
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